

## REMARKS

Applicants wish to thank the Examiner for the courtesy of conducting a telephonic interview with applicants' representative on October 16, 2003. During the interview the rejections in the Official Action of August 19, 2003 were discussed. Claims 1-9 and 14-27 were discussed. Applicants' representative also argued that these claims are not obvious or the same as the claims of U.S. patent 6,492,330 and U.S. patent application 09/248,382. Reference was made to the description in US patent application 09/248,382 that substitutions and/or deletions have been incorporated to offer conformational constraint and stability to the peptides. Relevant case law on obviousness was also discussed. The Examiner's description of the substance of the interview are incorporated herewith.

During the interview applicants' representative discussed the possibility of filing a declaration to show that the protecting groups would result in different advantages or unexpected effects but did not commit to filing such a declaration.

Claims 28-46 are in this application. Claims 1-27 have been cancelled. Claims 28-46 correspond to claims 2-7, 14-19 and 21-27 respectively.

The Examiner has rejected claims 1-9 and 14-27 under the judicially created doctrine of double patenting over claims 1-33 of US patent 6,492,330. Applicants respectfully traverse this rejection.

Claims 28-33 of this application claim specific peptides.

The peptides of SEQ ID NO: 9, 10, 11, 12, 13, and 15 claimed in claim 1 of the '330 patent all include at least an  $\alpha,\alpha$  dialkylated amino acid (for example Aib or Deg) or contain a D-amino acid. None of the sequences claimed in this application contain an  $\alpha,\alpha$  dialkylated amino acid or a D-amino acid.

The standard test used to establish *prima facie* obviousness is the test set out by the Supreme Court in *Graham v. John Deere* (383 US 1, 148 USPQ 459 (1966)). To determine whether a claim is *prima facie* obvious:

- 1) the scope and content of the prior art are to be determined;
- 2) the differences between the prior art and the claims at issue are to be ascertained; and

- 3) the level of ordinary skill in the pertinent art resolved.

In addition, according to MPEP 2141, citing *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n. 5 (Fed. Cir. 1986), when applying 35 USC 103, the following tenets of patent law must be adhered to:

- 1) the claimed invention must be considered as a whole;
- 2) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; and
- 3) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.

The reason, suggestion or motivation to combine references may be found explicitly or implicitly. While the references need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability must be clear and particular. *Ruiz v. A.B. Chance Co.*, 57 USPQ2d 1161 (Fed. Cir. 2000).

The Examiner states that the only difference between the claims of the '330 patent and the claims of this application are that X is an alkanoyl group. Applicants respectfully disagree. As stated above the peptides claimed in the '330 patent include at least one of  $\alpha,\alpha$  dialkylated amino acid (for example Aib or Deg) or contain a D-amino acid. To reach the claims of this application there must be at least a two step modification from the claims of the '330 patent. There is no suggestion in the '330 patent to include an alkanoyl group as the first group of the sequence and not to include  $\alpha,\alpha$  dialkylated amino acid or contain a D-amino acid. In fact, there is no suggestion or disclosure in the claims of the '330 patent or the specification of the '330 patent of the use of an alkanoyl group in the peptides. Therefore, the claims in this application cannot and are not obvious over the claims of the '330 patent.

Considering the factors of *Graham v. Deere*, it is clear that the claims in this application are not obvious over the claims of the '330 patent.

Therefore, it is respectfully requested that this rejection be withdrawn.

The Examiner has issued a provisional obviousness type double patenting rejection of claims 1-9 and 14-27 over claims 1, 3, 4 and 32-36 of co-pending application 09/248,381. Applicants respectfully request this rejection.

All of the peptides claimed in US patent 09/248,381 contain at least one an  $\alpha,\alpha$  dialkylated amino acid (for example Aib or Deg) or contain a D-amino acid. None of the sequences claimed in this application contain an  $\alpha,\alpha$  dialkylated amino acid or a D-amino acid. None of the peptides include an alkanoyl group.

As explained on page 3 of US patent application 09/248,381 the use of cyclic and acyclic dialkylated glycines result in conformational constraints and resist enzymatic degradation. Based on this disclosure, one would be motivated to use an cyclic or acyclic dialkylated glycine rather than prepare a peptide that does not contain such a modified amino acid.

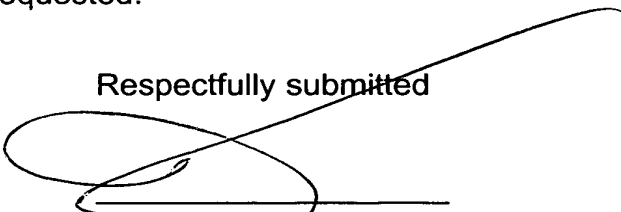
In addition, none of the peptides claimed in the 09/248,381 application include an alkanoyl group nor is there any suggestion of the use of such a group in that application.

There is no way to reach the claims in this application from the claims of US patent application 09/248,381.

Therefore, the claims in this application are not obvious over the claims of US patent application 09/248,281 and it is respectfully requested that the rejection be withdrawn.

Applicants submit that the present application is in condition for allowance and favorable consideration is respectfully requested.

Respectfully submitted



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